

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD SPECTOR

Appeal No. 98-1194
Application 08/630,669¹

ON BRIEF

Before ABRAMS, PATE, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Donald Spector originally took this appeal from the final rejection of claims 1 through 8. Subsequently, the appellant amended claim 1 and canceled 2 through 6. Thus, the appeal now involves claims 1, 7 and 8, the only claims presently

¹ Application for patent filed April 10, 1996.

pending in the application.

The invention relates to "pneumatic playballs in which an inflated bladder is confined within an outer casing, and more particularly to a playball of this type which has the appearance of the decapitated head of a humanoid, an animal-like or fanciful figure" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A pneumatic play ball in a kickable size that looks like the head of a humanoid, an animal-like or fanciful figure, said playball comprising:

A. a spherically shaped hollow casing molded of flexible foam plastic material, said casing having a smooth spherical inner surface and an irregular outer surface contoured to define the features of the head of the figure; and

B. a bladder confined within the casing and inflated therein to conform to the spherical inner surface of the casing whereby the resultant pneumatic ball resembles a decapitated head of the figure which is kickable by a player who is then metaphorically kicking the figure, the playball having a diameter close to that of a soccer ball or a basketball, said bladder being a rubber balloon, said casing being provided with a slit to admit into the casing the balloon in its deflated state, said balloon having a neck which projects from the slit for mouth inflation, after which the neck is tied and pushed under the slit.

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The references relied upon by the examiner as evidence of obviousness are:²

Eiseman	1,216,425	Feb. 20, 1917
Casey et al. (Casey)	2,324,277	Jul. 13, 1943

Claims 1, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eiseman in view of Casey and vice versa.

Reference is made to the appellant's main and reply briefs (Paper Nos. 12 and 15) and to the examiner's answer (Paper No. 14) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Eiseman discloses an inflatable toy comprising "a casing [10] of fabric or like inelastic material of oval, egg-shape or other elongated form and a substantially spherical inflatable balloon [17] within the casing, the balloon being

²Although the examiner has relied on U.S. Patent No. 3,923,304 to Warren in the answer (Paper No. 14, see page 5) to support his position, he has not included this patent in the statement of the rejection on appeal. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we have not considered the teachings of Warren in reviewing the merits of the examiner's rejection.

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formed of thin elastic rubber and adapted, when inflated, to conform to the outline of the elongated casing" (page 1, lines 23 through 30). The casing contains a slit 13 for accommodating the nipple or neck of the balloon.

Casey discloses an inflated rubber playing ball 10 bearing simulated human or animal facial features. In this regard, Casey teaches that

[t]he mold cavities are designed so that during the vulcanizing process internal pressure will force portions of the wall of ball 10 into irregular, relatively shallow, recesses to form portions on the outer surface of the ball projecting sufficiently to provide the desired design. These projections may be formed to simulate the eyes 11, 11, nose 12, mouth 13, ears 14, 14, hair 15, etc., of the irregular features of the so-called man in the moon, substantially as shown [page 1, column 1, lines 25 through 34].

In explaining the rejection on appeal, the examiner states that

Eiseman merely differs from appellant's ball in the simulation only of the head, the type of material used for the casing, and the ball being spherical in shape. Casey clearly teaches simulating only of the head, spherical shape, and an elastomeric material for a ball device. It would have been obvious to one of ordinary skill in the art at the time of appellant's invention to incorporate the features taught by Casey in the Eiseman ball as obvious alternatives in design

choice of well-known features for ball devices. Further, the use of an elastomeric material would be for better bounce and water resistance.

With respect to Casey in view of Eiseman, Casey merely differs from the invention in lacking of an inflatable bladder and a slit for the insertion of the bladder. Eiseman clearly discloses such conventional features for ball constructions. It would have been obvious to one of ordinary skill in the art at the time of appellant's invention to make the ball of Casey with the conventional features of an outer casing and an inflatable bladder as disclosed by Eiseman as also in obvious alternative design choice in ball constructions notoriously well-known to those of ordinary [skill] in the ball construction art. Further, the use of a bladder would be for the purpose of providing a "second skin" for holding the air in the ball [answer, pages 4 and 5].

Given the disparate natures of the balls disclosed by Eiseman and Casey, however, it is apparent that the reference combinations proposed by the examiner stem only from an impermissible hindsight reconstruction of the appellant's invention wherein the examiner has used the claims as a template to selectively piece together isolated disclosures in the prior art. Moreover, even if the proposed reference combinations were made, the resulting balls would still not meet the limitation in independent claim 1 requiring the spherically shaped hollow casing to be molded of flexible foam plastic material. We are therefore constrained to conclude

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that the combined teachings of Eiseman and Casey fail to establish a prima facie case of obviousness with respect to the subject matter recited in claim 1 and in claims 7 and 8 which depend therefrom.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of these claims.

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The decision of the examiner is reversed.

REVERSED

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NEAL E. ABRAMS))
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. PATE, III)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

JPM/caw

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